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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,991	04/12/2007	Guilin Peng	025251-0355925	7862

909 7590 01/07/2009
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EXAMINER

MUHAMMAD, KHALIF R

ART UNIT	PAPER NUMBER
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3685

MAIL DATE	DELIVERY MODE
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01/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,991	Applicant(s) PENG ET AL.	
	Examiner KHALIF MUHAMMAD	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/17/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/12/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's election with traverse of Group in the reply filed on 9/17/2008 is acknowledged. The traversal is on the ground(s) that the Office Action fails to show that Groups I and II are independent and distinct. This is not found persuasive because Group I claims 1-18 are drawn to an online payment system. However Group II is drawn to authenticating a user. Group II does not include or require the elements, such as the customer database as described in Group I. Also, Group II does not perform the customer entering the authorization code steps. Thus, the election/restriction is proper for at the least the following reasons: inventions have acquired a separate status in the art in view of their different classifications, the inventions require a different field of search; the prior art applicable to one invention would not likely be applicable to another invention. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 19-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed 9/17/2008.

Status of Claims

3. Claims 1-18 have been examined and rejected

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 1 is rejected under 35 U.S.C. 101 because if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.(i.e. the customer) (*MPEP §2105*)

4. Claims 2-18 are also rejected as each depend from claim 1.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. With respect to claims 1-18, the claims are generally narrative and indefinite, failing to conform with current U.S. practice.

8. With respect to claim 1, a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention.

In this particular case applicant recites a system which includes a “payment gateway”

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however goes on to describe how the "payment gateway" functions and that makes the scope of the claim unclear.

9. With respect to claim 1, applicant recites "...and said assistant authentication system connects said customer to said payment gateway in a non-Internet approach...", however it is unclear how this would be done. For purposes of examination this will be interpreted as a "networked approach".

10. Claims 5, 6 and 8 recites "...system is a dedicated device...", however the term "dedicated" is indefinite and for purposes of examination will be interpreted as "normal."

11. Claim 7 recites the limitation "the standard". There is insufficient antecedent basis for this limitation in the claim.

12. Claims 2-18 are also rejected as each claim depends from claim 1.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claim 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater (US 6947908) in view of Hutchison (US 7249097).

15. With respect to claim 1, Slater discloses an online payment system, comprising:

- a customer's bank of account or agency bank, i.e., the party that can confirm the customer's account information and execute deduction for payment, (fig 2; col 8 lines 8-50)
- wherein the customer, i.e., the buyer, is the party that a certain amount of money will be deducted from his/her account to pay a merchant, (fig 2; col 8 lines 8-50)
- a payment gateway, which is a system responsible for handling payment information from the network, authenticating the customer and the merchant, and confirming authenticity and validity of a transaction; (fig 2; col 8 lines 8-50)
- the customer, the merchant, and the payment gateway being connected to each other over Internet; (fig 2; col 8 lines 8-50)
- after processing system of the payment gateway confirms legality of the transaction, the payment gateway sending a payment request, and, after the payment is completed, the payment gateway informing the two parties (i.e., the customer and the merchant) involved in the transaction of the payment information; (col 9 lines 45-62)
- the payment gateway communicating with the customer and the merchant at one side to authenticate identity of the customer and identity of the merchant

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- (password-based identity authentication for the customer, and certificate-based identity authentication for the merchant) (col 3 lines 43-67 thru col 4 lines 1-10)
- and confirming the transaction and transaction value; (col 3 lines 43-67 thru col 4 lines 1-10)
 - and the payment gateway communicating with the bank of paying account and the bank of collecting account at the other side, to transfer payment request and deduction information; (col 6 lines 1-17)
 - wherein said payment gateway has a customer information database, which stores the customer's actual identity, the customer's identity for online transaction, and the basic information of the customer's account; (col 4 lines 11-27)
 - the merchant's bank of collecting account or agency bank, wherein the merchant, which is also referred to as the service provider or the merchandise provider, is the party that will collect the payment, (col 6 lines 35-55)

However Slater does not disclose the following limitations that are disclosed by Hutchison et al. Where there is arranged an assistant customer identity authentication system between said payment gateway and said customer, and said assistant authentication system connects said customer to said payment gateway in a non-Internet approach; (fig 12). After the payment gateway verifies the customer's identity for online transactions has been logged in the customer information database (i.e., the customer's identity is valid), it generates an authorization code for the received payment

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request, and sends the authorization code to the customer via the assistant customer identity authentication system;(fig 14 step 1420). After the customer receives that authorization code, the customer enter the authorization code on the correct page in the payment gateway; (fig 14 step 1430). After verifying the authorization code successfully, the payment gateway confirms the customer has passed the identity authentication, (fig 14 step 1498) sends the payment information, obtains the processing result from the bank, and forwards the processing result to the customer and the merchant. (fig12)

It would have been obvious to one having ordinary skill in the art to combine the payment system of Slater with the payment system of Hutchison in order to make ordering and billing for goods more effective and secure.

16. With respect to claim 2, Hutchison discloses the online payment system as in claim 1, wherein said assistant customer identity authentication system comprises a customer terminal and a switch system; (fig 12)

said customer terminal has its initial information registered in the payment gateway; said switch system connects said customer terminal to said payment gateway, and receives information from said payment gateway and forwards the information to said customer terminal. (fig 12)

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17. With respect to claim 3, Hutchison discloses the online payment system as in claim 2, wherein the information received by said switch system from said payment gateway comprises an authorization code and transaction information. (fig 14)

18. With respect to claim 4, Hutchison discloses the online payment system as in claim 1, wherein said authorization code is generated dynamically and has a validity period;

said authorization code is deemed as valid only **when** it is inputted on the correct page in the payment gateway within the validity period; otherwise said authorization code will be deemed as invalid. (col 24 lines 56-67; col 26 lines 10-25)

19. With respect to claim 5, Hutchison discloses the online payment system as in claim 2, wherein said customer terminal of the assistant customer identity authentication system is a dedicated device, and has its initial information registered in the payment gateway. (abstract; fig 12)

20. With respect to claim 6, Hutchison discloses the online payment system as in claim 5, wherein said customer terminal is a dedicated device separately configured, and is provided by said payment gateway. (abstract; fig 12)

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21. With respect to claim 7, Hutchison discloses the online payment system as in claim 5, wherein said customer terminal is a device conforming to the standard of said payment gateway. (abstract; fig 12)

22. With respect to claim 8, Hutchison discloses the online payment system as in claim 5, wherein said customer terminal is a dedicated switching card provided by said payment gateway, and is inserted in a personal or home electronic or electrical device such as a STB or a remote controller, etc. (col 7 lines 1-34)

23. With respect to claim 9, Hutchison discloses the online payment system as in claim 2,

- wherein the customer terminal of said assistant customer identity authentication system is a non-dedicated device, such as a telephone, a mobile telephone, a BP, or a PDA, etc.; col 7 lines 1-34)
- **before** said non-dedicated device can be used as the customer terminal, it shall have its initial information registered in the payment gateway or a place designated by the payment gateway. col 7 lines 1-34)

24. With respect to claim 10, Hutchison discloses the online payment system as in claim 2, wherein the initial information of said customer terminal registered in the payment gateway may be one or more information of the customer terminal. (fig 12)

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25. With respect to claim 11, Hutchison discloses the online payment system as in claim 2, but not wherein said customer terminal that is used to receive the authorization code may not be a customer terminal with initial information registered in the payment gateway. However It has been held that actions that may or may not be done is indefinite and does not distinguish the claim from the prior art. (*In re Collier*, 158 USPQ 266 (CCPA 1968))

26. With respect to claim 12, Hutchison discloses the online payment system as in claim 1,

- wherein there is a bank's information processing system between the payment gateway and the bank; (col 3 lines 29-67)
- said bank's information processing system is connected to the payment gateway, the payer's bank of paying account or agency bank, and the payee's bank of collecting account or agency bank; (col 3 lines 29-67)
- the payment gateway sends the payment request to said bank's information processing system and obtains the processing result (successful deduction or payment rejection) of the payment request from said bank's information processing system. (col 3 lines 29-67)

27. With respect to claim13, Hutchison discloses the online payment system as in claim 12, wherein said payment gateway and said bank's information processing system are network platforms provided by different entities. (col 5 lines 20-35)

28. With respect to claim 14, Hutchison discloses the online payment system as in claim 12, wherein said payment gateway and said bank's information processing system are network platforms provided by the same entity. (col 5 lines 20-35; col 14 lines 14-20)

29. With respect to claim 15, Hutchison discloses the online payment system as in claim 12, wherein said bank's information processing system is a network platform provided by the payer's bank of account. (col 5 lines 20-35)

30. With respect to claim 16, Hutchison discloses the online payment system as in claim 12, wherein said bank's information processing system is a network platform provided by the payment collecting bank or its agency bank. (col 5 lines 20-35)

31. With respect to claim 17, Slater discloses the online payment system as in claim 13, wherein said payment gateway and said bank's information processing system are network platforms provided by a third party irrelevant to the transaction. (col 5 lines 20-35).

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32. With respect to claim 18, Hutchison discloses the online payment system as in claim 1, wherein said payment gateway has a customer information database, which stores the customer's information and the customer's bank account information; the customer's identity in said customer information comprises the customer's actual identity and identity for online transactions; said identity for online transaction can be the customer's actual identity or an identity specified by the customer freely. (fig 6, col 10 35-55)

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHALIF MUHAMMAD whose telephone number is (571)270-5207. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hewitt Calvin can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KHALIF MUHAMMAD/
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685